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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,619	12/10/2001	Paul L. Frattini	060825-0306US	4759
24341	7590	10/28/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			PALABRICA, RICARDO J	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/014,619	FRATTINI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rick Palabrica	3663	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 23,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 24-26, and 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

EA

### DETAILED ACTION

1. Applicant's 9/23/05 Amendment, which withdrew claim 23 and traversed the rejection of claims, is acknowledged. This Amendment is in response to the 5/9/05 Office action.

2. Applicant traversed the rejection of claims 21, 22, 24-26, and 29-40 under 35 U.S.C. 112, second paragraph, on the ground that they are not indefinite on the basis of *Moore vs. Standard Register* and *Orthokinetics vs. Safety Travel Chairs* case laws. The Examiner disagrees because these case laws pertain to patents that have different claims construction compared to Applicant's case, and are therefore not applicable.

The *Moore vs. Standard Register* case pertains to the Lombardo patent (U.S. 5,253,798) and the issue regarding the indefiniteness of the term, "distance sufficient." This term is recited in claim 1 that states the following limitation:

*"[S]aid first transverse pattern of adhesive being spaced from its associated transverse edge a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer." Underlining provided.*

Note that the limitation regarding the element, "transverse edge" is part of an intended or desired use clause, "to insure that the adhesive does not interfere with rollers ..."

In the *Orthokinetics vs. Safety Travel Chairs* case, the issue pertains to the following claim limitation:

*"[W]herein said front leg portion is so dimensioned as to be insertable through the space between the door frame of an automobile and one of the seats thereof."*

Again, note that the limitation regarding the element, "front leg portion", is part of an intended use or desired clause, "to be insertable through the space between ..."

In Applicant's case, claim 1 reads:

*"[W]herein said housing has a length at least as long as the irradiated nuclear fuel assembly."*

Compared to the above-cited case laws, Applicant does not recite the limitation on the housing as part of an intended or desired use clause, but as part of a positively recited element in the body of the claim, i.e., "irradiated nuclear fuel assembly." Thus, the claim structure in Applicant's case is totally different from those in the patents of the case laws he attempts to use as basis for his arguments.

Additionally, the positive recitation of the fuel assembly in the body of Applicant's claim 1 is inconsistent with the preamble where said fuel assembly is part of an intended or desired use clause for the claimed apparatus. By this inconsistency alone, the claims are already rejectable under 35 U.S.C.112, second paragraph, because there is no proper antecedent for the "irradiated nuclear fuel assembly" in the body of the claim.

3. Applicant traversed the rejection of claims based on Fiorenzo on the ground that he "describes a process for total decontamination or decommissioning of heat exchanger tubes that have been exposed to radioactive material – not nuclear fuel assemblies." Underlining provided. The Examiner disagrees.

First, Applicant's claims are directed to an apparatus and not to a process. The Examiner based his rejection on Fiorenzo's apparatus and not on his process.

Second, the "nuclear fuel assemblies" that Applicant uses as basis for his argument is an intended or desired use of the claimed apparatus. As stated in section 3

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of the 5/9/05 Office action, intended or desire use clauses do not serve to patently distinguish the claimed structure over that of a reference, as long as the structure of the cited reference is capable of performing the intended use. Such is the case for Fiorenzo, whose apparatus comprise the same elements as Applicant's apparatus.

4. Applicant further traversed Fiorenzo because: a) Fiorenzo's use of the term, "homogeneous power density" is "not an indication of the type of transducer being used, and b) "if Fiorenzo were discussing the energy to be applied to the wall of the outer tank from the transducers, it is most likely that such would be done using the terms or units associated with planar transducers." Underlining provided.

First, the above statements have no probative value because these are Applicant's own opinion, i.e. they constitute no more than uncorroborative statements of the Applicant (see MPEP 716.01(c)).

Second, Fiorenzo uses the broad term, "ultrasound emitting piezoelectric transducers", which inherently includes both planar and omnidirectional transducers. As such, nowhere in Fiorenzo does he exclude any particular type of transducer from providing a homogeneous power density of 25 W/I for his invention. This remark also applies to Applicant's comment regarding the Gross declaration.

5. Applicant also traversed Fiorenzo on the ground that he "does not teach or suggest anything about the node structure of the transducers used relative to nuclear

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fuel rod spacing." Underlining provided. The Examiner disagrees for the same reason given in section 3 above.

6. Applicant traverse of the secondary references, i.e., Walter, Kato, Richardson and Scharon, is essentially based on the primary reference, Fiorenzo, not meeting the limitations of the base claim. The Examiner disagrees because the base claim does not define over Fiorenzo, as discussed above. Additionally, Applicant has not shown that the combination of the primary reference with the associated secondary reference(s) do not teach what the Examiner has stated they teach, nor, has the Applicant shown that the Examiner's reasoning for and manner of combining the teachings of the references is improper or invalid.

Applicant, in particular, objects to Scharon because he alleges that Scharon "applies to cleaning of heat exchangers as opposed to nuclear fuel assemblies." Once again this objection has no basis because the cleaning of nuclear fuel assemblies is part of the intended use clause of the claimed apparatus. See also section 3 above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21, 22, 24-26, and 29-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The reasons are the same as those in pages 2 and 3 of the 5/9/05 Office action, as further clarified in section 2 above, which reasons are herein incorporated.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21, 22, 24, 29, 31, 32, and 37-39 rejected under 35 U.S.C. 102(b) as being anticipated by Fiorenzo et al. (EP 0418722 A1).

The reasons are the same as those in pages 4 and 5 of the 5/9/05 Office action, as further clarified in sections 3-5 above, which reasons are herein incorporated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiorenzo et al. in view of Walter et (U.S. 5,200,666).

The reasons are the same as those in page 6 of the 5/9/05 Office action, as further clarified in section 6 above, which reasons are herein incorporated.

10. Claims 30, 33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiorenzo et al. in view of the combination of Kato et al. (U.S. 5,467,791) and Richardson et al. (U.S. 5,377,237).

The reasons are the same as those in pages 7 and 8 of the 5/9/05 Office action, as further clarified in sections 6 above, which reasons are herein incorporated.

11. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiorenzo et al. in view of the combination of Scharton et al. (U.S. 4,320,528), Kato et al. (U.S. 5,467,791) and Richardson et al. (U.S. 5,377,237).

The reasons are the same as those in pages 8 and 9 of the 5/9/05 Office action, as further clarified in sections 6 above, which reasons are herein incorporated.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:30-5:00, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJP  
October 26, 2005

A handwritten signature in black ink, appearing to read "R. Palabrica", with a long, sweeping horizontal stroke extending to the right.